



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Cruickshank, et al.

Application No.: 09/554,426

Attorney Docket No.: 1025-P02184US0

Filed: May 12, 2000

For: "COMMUNICATIONS TERMINAL AND RECEIVED
OPERATING METHOD"

Examiner: Qureshi, Afsar M.

FEB 09 2004

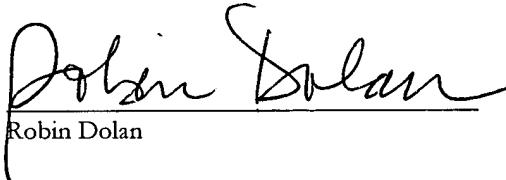
Group Art Unit: 2667

Technology Center 2600

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this Amendment and accompanying papers are being deposited on February 4, 2004 with the United States Postal Service as first-class mail in an envelope properly addressed to COMMISSIONER OF PATENTS, Alexandria, VA 22313-1450.

February 4, 2004
Date of Certificate


Robin Dolan

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT

Applicants have received a Notice of Non-Compliant Amendment in an Office Action dated January 9, 2004. The Notice states that the Applicants' claim amendments submitted as an exhibit to Applicants' Response on December 29, 2003 fail to meet the requirements of 37 C.F.R. § 1.121, as amended June 30, 2003. Applicants respectfully submit, however, that the Notice of Non-Compliant Amendment is in error.

The claim amendments purportedly at issue in the Notice of Non-Compliant Amendment were presented as a preliminary amendment filed concurrently with the original National Phase Application on May 12, 2000, over three years ago. On September 23, 2003, the Patent Office Examiner issued a first Office Action which examined the claims in the Applicants' national phase application, but the Examiner mistakenly disregarded the claims submitted in the preliminary amendment filed on May 12, 2000. Accordingly, in a

Response filed on December 29, 2003, Applicants notified the Examiner that the preliminary amendment of May 12, 2000 had not been considered by the Examiner. For the convenience of the Examiner, Applicants attached a copy of the previously filed preliminary amendment and the accompanying transmittal letter as an exhibit to Applicants' Response of December 29, 2003 to demonstrate to the Examiner that the preliminary amendment had been properly filed on May 12, 2000, more than three years prior to the issuance of the first Office Action that failed to take into account such preliminary amendment. The exhibit to Applicant's response of December 29, 2003 was not a formal submission of claim amendments subject to 37 C.F.R. § 1.121, because such claim amendments had already been filed on May 12, 2000.

The revised requirements under 37 C.F.R. § 1.121 apply to amendments filed on or after July 30, 2003. (68 Fed. Reg. 38611, June 30, 2003). The preliminary amendment at issue was filed on May 12, 2000. Consequently, the preliminary amendment filed on May 12, 2000 is not subject to the revised requirements under 37 C.F.R. § 1.121 effective July 30, 2003. Applicants' preliminary amendment was compliant with all applicable requirements that existed at the time of original filing, almost three years prior to the effective date of the format revised requirements under 37 C.F.R. § 1.121. Therefore, the Patent Office is obligated to examine the preliminary amendment as it was originally filed on May 12, 2000. Moreover, the exhibit submitted on December 29, 2003 is not and does not constitute a new amendment that is subject to the revised requirements under 37 C.F.R. § 1.121. Indeed, Applicants made no claim amendments whatsoever in the response filed on December 29, 2003. Applicants, therefore, respectfully request that the Notice of Non-Compliant Amendment be withdrawn, and the preliminary amendment be considered in its current format. It is improper to retroactively apply requirements that were not effective until July 30, 2003 to a preliminary amendment filed three years earlier on May 12, 2000.

The Examiner is encouraged to contact the Applicants' undersigned attorney if the Examiner has any questions or believes that issues remain regarding the preliminary amendment.

Respectfully submitted,

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